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Date July 2, 2002

Connie Charniak
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON APPEAL

Applicant : Glacier Northwest, Inc.
Serial No. : 75/878,230
Filed : December 21, 1999
Mark: G GLACIER NORTHWEST and Design in Class 1



TM Attorney : Idi Aisha Clarke
Law Office : 105
Docket No. : 610028.205
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APPLICANT'S REPLY TO EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant wishes to respond to specific issues raised by the Examining Attorney's Appeal Brief of June 14, 2002.

I. NUMEROUS THIRD PARTY "GLACIER" REGISTRATIONS SHOULD BE CONSIDERED IN ASSESSING THE STRENGTH OF THE CITED MARK

The Examining Attorney offers no substantive response to the fact that there are numerous third-party "GLACIER" marks, which tends to weaken the cited mark and make confusion unlikely. (See Applicant's Opening Brief at pp. 6-7.) Instead, the Examining Attorney argues that she need not consider them and urges the Board to do likewise. The Examining Attorney takes this position even though (1) she did not raise this objection when the evidence was first submitted and any alleged defect could have been easily corrected at that time; and (2) she previously accepted the same type of evidence without objection as to the term "NORTHWEST."

A. *The Examining Attorney Should Be Estopped from Objecting to Applicant's Third Party GLACIER Registration Listings*

The Examining Attorney should be estopped from objecting to Applicant's evidence. Applicant filed the third party GLACIER registration listings with its Request for Reconsideration. No objection to the nature of the evidence was made at that time. Instead, the Examining Attorney waited until the Examining Attorney's Appeal Brief to object. An objection made in the Examining Attorney's response to the Request for Reconsideration would have enabled Applicant to efficiently correct the alleged minor deficiency of not submitting complete excerpts from the PTO database. Furthermore, the Examining Attorney never objected to Applicant's similar listing of third party registrations containing the NORTHWEST mark in the first Office Action. The third party NORTHWEST listings and the GLACIER listings were acquired from the same database (Trademark.com), which gets its data directly from the PTO records (see attached Declaration of Jerry R. Lewis). The Examining Attorney has taken inconsistent positions with respect to accepting the NORTHWEST registration listings, but objecting to the GLACIER registration listings, both compiled from the same private database. The Examining Attorney's inconsistent actions induced Applicant to justifiably rely on using third party registration listings as evidence. Therefore, Applicant respectfully requests that the Board deny the Examining Attorney's evidentiary objection regarding the GLACIER registration listings.

B. *The Board Can and Should Take Judicial Notice of Applicant's Evidence*

The Board takes judicial notice of registrations only when copies of the registrations, not mere listings, have been submitted as evidence. *In re Duofold*, 184 USPQ 638, 640 (TTAB 1974). Applicant should submit photocopies of the PTO's records to have the Board consider them. Gary D. Krugman, *Trademark Trial and Appeal Board Practice and Procedure*, § 2.05[2][a], 2-18 (2002 ed., West 2001). On the other hand, the Board takes judicial notice of general dictionary references as long as the references are cited in the record. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1998).

The Federal Circuit and the Trademark Trial and Appeal Board have noted that third party registrations have probative value when used similar to dictionaries to show how language is generally used in a descriptive or vague sense and hence entitled to a narrow scope of protection. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 USPQ 1281 (Fed. Cir. 1984), *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ 693, 694-95 (C.C.P.A. 1975); and *In re Mucky Duck Mustart Co. Inc.*, 6 USPQ2d 1467, 1470 (TTAB 1988). The Board's policy is to accept general references such as dictionary terms. Gary D. Krugman, *Trademark Trial and Appeal Board Practice and Procedure*, § 2.05[2][b], 2-18 (2002 ed., West 2001). Applicant believes that the Board's policy of accepting dictionary definitions to show how the public uses a word is equally applicable to the use of third party registration listings, sans excerpts, to show the commonality or vagueness of a mark.

Applicant submitted a listing of over 300 federal filings containing the mark GLACIER as evidence in support of Applicant's Request for Reconsideration. The third party federal filings containing the GLACIER term were submitted to identify the narrow scope of protection that should be afforded that term. For evidentiary purposes, therefore, it should be irrelevant whether Applicant submitted a list of third party federal filings or the actual excerpts. Based on the facts at hand and the aforementioned policy, Applicant respectfully asks that the Board take judicial notice of Applicant's third party listing of marks containing the GLACIER term without requiring the respective excerpts from the PTO database.

C. *Alternatively, the Board Can and Should Accept Applicant's Submittal of the "GLACIER" Excerpts With this Reply*

In the alternative, Applicant submits with this Reply copies of 168 GLACIER excerpts from the electronic record of the U.S. Patent and Trademark Office. These listings are from a search conducted on July 1, 2002 and include only "active" listings. Applicant respectfully asks that the Board accept these copies as supplemental evidence to the 300+ GLACIER listings (which included both live and dead listings) initially placed on record. These copies from the PTO's electronic records are not prejudicial to the Examining Attorney because they only reiterate the evidence previously submitted.

Accordingly, Applicant respectfully requests that the Board deny the Examining Attorney's evidentiary objection of the third party federal filings containing the GLACIER term. Applicant asks that the Board take judicial notice of Applicant's third party GLACIER evidence even though excerpts were not initially provided, or, in the alternative, accept the enclosed excerpts from Applicant's copies from the PTO records as supplemental evidence in place of the originally submitted search report.

II. *THERE IS NO LIKELIHOOD OF CONFUSION WHEN APPLICANT'S MARK IS VIEWED IN ITS ENTIRETY*

The Examining Attorney refused registration of Applicant's mark based on the assertion that it is likely to be confused with the mark GLACIER for "manufactured stone" (U.S. Reg. No. 1,100,766). The Examining Attorney's Brief improperly dissects Applicant's mark and improperly discounts the strong graphic elements of Applicant's mark.

A. *The Design Element of the Mark Is Not Dwarfed by the GLACIER Term*

The Examining Attorney argues that the "G" and Star Design in the mark does not change the commercial impression of the mark because the term GLACIER is the most prominent portion of the mark. The Examining Attorney also expresses the opinion that the term GLACIER *dwarfs* the design element of the mark.

Applicant wholly disagrees with the Examining Attorney's opinion that the GLACIER term *dwarfs* the Star Design. Applicant's mark is a five-sided star with a G in the

center, shown below, proportionally scaled, to indicate that the Examiner's assertion is without merit.



The prominent topmost tip of the Star Design forms the upper limit of the design feature envelop. More importantly, the prominent and eye-catching lower tip of the Star Design extends below the term GLACIER, forming part of the "A" in GLACIER. Proportionally speaking, the Star Design actually *dwarfs* the GLACIER term in height by over a factor of four (i.e., the height of the term GLACIER is less than $\frac{1}{4}$ of the height of the Star Design). In terms of a proportional width comparison, the GLACIER term is only a mere two times as wide as the Star Design. The relative geometric differences clearly establish the Star Design as the prominent element within the mark as viewed in its entirety.

Applicant believes that the "G" and Star Design in the mark imparts a strong commercial impression upon Applicant's relevant and sophisticated consumers. The Examining Attorney plainly acknowledges that Applicant's design is "*fanciful*." See Examining Attorney's Appeal Brief at page 5. First, Applicant acknowledges that the "G" nestled within the Star Design is not readily prominent. However, this lack of prominence and the fanciful nature of the Star Design cause consumers to take a second look at Applicant's mark in an effort to identify the distinctiveness of the design and verify that the letter "G" actually resides within the star. Second, Applicant's goods are "concrete additives." This being the case, Applicant owns many concrete trucks where the G GLACIER NORTHWEST and Star Design are prominently displayed on the side of concrete mixers drums, which rotate as the concrete truck travels along the roadway. As mentioned, the height of the star relative to the GLACIER term is such that a consumer sees the Star Design for the majority of the rotation cycle. In the Examining Attorney's own words, "consumers are likely to see this [star] design as the image to associate with the Applicant's goods." See Examining Attorney's Appeal Brief at page 5. Consumers can easily, and without mistake, recognize that Applicant's goods (i.e., the concrete in the noticeable rotating drum of the concrete truck) are affiliated with the company who uses the *fanciful* Star Design as a source identifier. Applicant firmly believes that its fanciful Star Design is the most

prominent feature of the mark and is the feature that allows consumers to make the requisite association with the source of Applicant's goods.

B. *The Star Design Element of the Mark Should Be Afforded Greater Force and Effect Compared to the GLACIER Term*

The Examining Attorney states, "When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services." *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987) and *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976).

In determining whether a likelihood of confusion exists in a composite mark, a mark consisting of words and designs, the Examining Attorney should not necessarily focus on the word element of the mark. The fundamental rule is that composite marks must be considered in their entireties. E.g., *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272 (C.C.P.A. 1974). More importantly, if one feature of a mark is more significant than another feature, whether it be the word or design feature, it is proper to give greater force and effect to that dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390 (Fed. Cir. 1983) and TMEP § 1207.01(b)(iv).

The Examining Attorney relies on the rule as cited directly from *Amoco*. However, the Board in *Appetito*, more recently decided, clarifies the *Amoco* rule and stresses the context in which the rule is applicable. The Board in *Appetito* correctly recognized that if one of the marks comprises both a word and a design, then the word is *normally* accorded greater weight only if purchasers who request the goods and services would readily use the word in making such a request. *Appetito*, 3 USPQ2d at 1554 (emphasis added). The Board went further and stated the principle behind giving a word mark more weight with respect to consumer impression is relevant in cases involving restaurant services in view of the propensity of persons to try restaurants based on word-of-mouth recommendations. *Appetito*, 3 USPQ2d at 1554.

In *Appetito*, the Board held that Applicant's mark was confusingly similar to the registrant's mark. The Board found that the design element of Applicant's mark was merely "broad stripes" around the word "appetito" and the registered mark's design element was a sandwich. Neither of these design features were noted as being fanciful or distinctive in any manner. The Board stated that consumers would likely not remember the sandwich design

element of the registered mark because the sandwich design merely describes the registrant's business and the kind of food served in its restaurants. In other words, consumers would likely be using the word *appetito*¹ or appetite in the context of requesting sandwiches. Therefore, the Board correctly concluded, under this set of facts, that the word portion of the mark should be afforded more weight in the likelihood of confusion analysis. Applicant believes that if either mark in *Appetito* had contained a fanciful design element, then the Board certainly would have afforded that feature much greater force and effect.

Applicant's mark does contain a noticeable and fanciful design feature; the Star Design with the enclosed "G." Applicant's graphic and the GLACIER term are integrally connected by the prominent, left lower point of the Star Design; whereas Applicant's mark in *Appetito* was simply surrounded by broad stripes. Unlike the registrant's sandwich mark in *Appetito*, where both the text and design were related to the goods; Applicant's Star Design and text is completely unrelated to "concrete additives." The terms "glacier" and "northwest," when combined, tend to allude to the popular beauty of the Pacific Northwest's snow-capped mountains. The Examining Attorney concurs that the term GLACIER alone "obviously creates an image of an actual glacier." See Examining Attorney's Appeal Brief at page 4. This fanciful commercial impression is prominently enhanced by the Star Design of the mark, which comprises a sharp peak adjoined by a steeply angled slope that slices through the term "GLACIER" in a visually overpowering manner. As previously noted, the Examining Attorney has acknowledged that Applicant's Star Design is indeed fanciful. See Examining Attorney's Appeal Brief at page 5. Accordingly, Applicant believes that the fanciful nature of its Star Design should be afforded the greatest weight as the Board views Applicant's mark in its entirety. The Star Design is obviously the prominent feature and therefore obviates any likelihood of confusion with respect to the registered mark consisting simply of the text, GLACIER, for manufactured stone.

Applicant further distinguishes the facts of this case to *Appetito* by noting that Applicant is not in the restaurant industry, where even fanciful words become part of the common language for consumers to request goods. Consumers do not ask for Applicant's concrete or concrete additives by even remotely using the words "glacier", "northwest", "G", or "star." Despite the fact that the word "glacier" may be descriptive of deep, cracking ice on the

¹ The word "appetito" is an Italian word meaning "appetite." *Appetito*, 3 USPQ2d at 1553 (footnote 1).

side of a mountain; there is simply not any descriptive connection of the word "glacier" with Applicant's concrete additives. Applicant stresses that the rule from *Appetito* not be applied in a blanket fashion, but instead must be conformed to the particular facts. Consequently, because consumers do not need to use any portion of either the Applicant's G GLACIER NORTHWEST and Star Design mark or the registered GLACIER mark in requesting the respective goods, then Applicant respectfully requests that the Board give Applicant's Star Design feature full force and effect and hold that there is no likelihood of confusion.

III. CONCLUSION

Although not necessary to find no likelihood of confusion, these marks show that the cited registration is weak. Applicant's mark contains a prominent and fanciful Star Design which the Examining Attorney improperly discounted in her analysis and Brief. Applicant respectfully requests that the Board deny the Examining Attorney's request to exclude the GLACIER third party federal filings, which were properly made of record. Applicant asks the Board to reverse the Examining Attorney's refusal under Trademark Act Section 2(d) and allow Applicant's mark to pass to publication on the Principal Register.

Respectfully submitted,

Glacier Northwest, Inc.

Seed Intellectual Property Law Group PLLC



William O. Ferron, Jr.

Enclosures:

Postcard

Declaration of Jerry R. Lewis

Excerpts of third party GLACIER (live) federal filings

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